

REMARKS

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13 – 17, and 20 – 30 are pending. Claims 1, 23, 26, 27, and 30 are currently amended.

Claims 1, 27, and 30 are hereby amended to delete the objected to claim language and to recite that process steps of the invention are carried out as a batch process. Claim 23 is being amended to recite that the acid catalyst is selected from the group consisting of sulfuric acid, nitric acid, hydrochloric acid, hydrobromic acid, hydroiodic acid, trifluoroacetic acid, and mixtures thereof (basis therefor being found, for example, at page 8, line 28, through, page 9, line 2). Claim 26 is being amended to change “insect mating disruption product” to “insect mating disruption composition.”

Rejections Under 35 U.S.C. § 112

Claim 23 has been rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement description. The rejection is respectfully traversed for the following reasons.

Claim 23 is directed to the process of claim 1 wherein the diol and the carboxylic acid are reacted in the presence of an acid catalyst. The Examiner has asserted that this claim is not enabled because the specification does not “reasonably provide enablement for all catalysts known in the field of chemistry.” The Examiner contends that “any acidic catalyst would not work on the claimed process in the same way” and supports this assertion with two examples.

As submitted in Applicants’ reply of March 8, 2007, Applicants respectfully disagree with the Examiner. However, in order to advance prosecution, Applicants have amended the claim so the acid catalyst is selected from the group consisting of sulfuric acid, nitric acid, hydrochloric acid, hydrobromic acid, hydroiodic acid, trifluoroacetic acid, and mixtures thereof. The Examiner’s rejection has therefore been obviated by amendment and Applicants respectfully request that the rejection be withdrawn.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13 – 17, and 20 – 30 have been rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The rejection is respectfully traversed for the following reasons.

The Examiner has asserted that the phrases “said process being conducted without a continuous extraction step” and “wherein the process does not comprise a continuous extraction step” in claims 1, 27, and 30 are new matter because these phrases lack “a literal description in the original specification.”

For the reasons submitted in Applicants’ reply of March 8, 2007, Applicants respectfully disagree with the Examiner. Again, however, in order to advance prosecution, Applicants’ have amended the claims to delete the negative limitation. Currently amended claims 1, 27, and 30 specify that the reaction step of the process of the invention is a batch process step.

This amendment is supported by the specification and is not new matter. A literal description in the original specification is not required. As stated in MPEP § 2163, “[N]ewly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.” While the original specification does not expressly use the phrases “batch process” this claim limitation is clearly supported in the specification through implicit disclosure.

The Background section of the original specification discusses shortcomings in the prior art, including the shortcoming that many prior art approaches for transforming diols into monoacetates “require specialized equipment such as continuous extraction apparatuses” (page 2, lines 21 – 25). The Summary section of the original specification goes on to explain that Applicants “recognize that in order for a process [for preparing monoacetates from diols] to be commercially viable, it should eliminate the necessity for specialized equipment [i.e., continuous extraction apparatuses]” and that surprisingly the claimed process “does not require specialized equipment [i.e., continuous extraction apparatuses]” (page 3, lines 1 – 9 and 19 – 24).

In view of the foregoing, one of ordinary skill in the art would recognize that the processes of the invention do not require a continuous extraction step and that they can be carried out as a batch process. Furthermore, in the examples, Applicants describe using a simple round bottom flask for carrying out the process of the invention as a batch process. Applicants therefore respectfully request that the rejection of claims 1, 2, 4, 5, 7, 8, 10, 11, 13 – 17, and 20 – 30 under 35 U.S.C. § 112, first paragraph, be withdrawn.

The Examiner has also asserted that claim 26 is vague and indefinite. Applicants have amended claim 26 as suggested by the Examiner and respectfully request that the rejection be withdrawn.

Rejections Under 35 U.S.C § 103

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13 – 17, and 20 – 30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Babler et al. The rejection is respectfully traversed for the following reasons.

Applicants' claimed process is carried out using as a batch process. Babler does not teach or suggest a process for preparing monoesters conducted as a batch process without a continuous extraction step. For at least this reason, and the reasons presented in Applicants' communication filed on October 11, 2006, Applicants respectfully submit that the teaching of Babler fails to make obvious Applicants' claimed invention. Applicants therefore respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

Concluding Remarks

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration and allowance of the application is requested. Should the Examiner not view the claims as being allowable in view of the foregoing amendments and remarks, Applicants' Attorney respectfully requests an opportunity to discuss any remaining issues by phone at the Examiner's convenience.

Respectfully submitted,

June 6, 2007
Date

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